

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

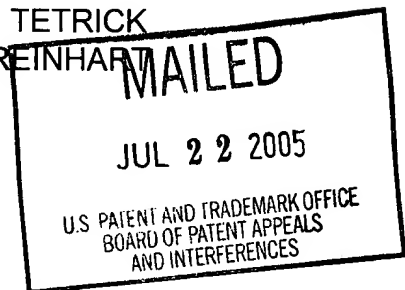
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GREGORY D. SUNVOLD, MARK A. TETRICK
GARY M. DAVENPORT, and GREGORY A. REINHART

Appeal No. 2005-1166
Application No. 09/609,622

ON BRIEF



Before SCHEINER, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 15-24. Claim 15 is representative of the subject matter on appeal, and reads as follows:

15. A composition comprising an effective weight reducing amount of L-carnitine, chromium, Vitamin A, and at least one carbohydrate selected from the group consisting of sorghum, barley, and mixtures thereof, which composition is formulated as a solid pet food.

The examiner relies upon the following references:

Nakatsu et al. (Nakatsu)	5,240,692	Aug. 31, 1993
Hastings et al. (Hastings)	5,626,849	May 06, 1997

Purina CNM Veterinary Product Guide pp. 16 and 17 (1994)

Claims 15-24 stand rejected under 35 U.S.C. § 103(a) over the combination of Hastings, Purina and Nakatsu. After careful review of the record and consideration of the issue before us, we reverse.

DISCUSSION

Purina is relied upon for teaching a dog food formulation for obese dogs, which includes ground corn and vitamin A. See Examiner's Answer, page 3. The rejection acknowledges that "[t]he reference does not teach using sorghum, barley, l-carnitine, or chromium in the composition." Id.

Nakatsu is relied upon for teaching "a food for reducing weight in animals," wherein corn, sorghum or barley may be used as the carbohydrate source. Id. Thus, according to the rejection, "the reference shows it was known in the art at the time of the invention that corn, sorghum, and barley can be used interchangeably as the carbohydrate source in a weight loss food. Therefore, a person of ordinary skill in the art would reasonably expect that substituting sorghum and / or barley for the corn in the Purina weight loss food would be successful." Id.

The Answer concludes:

Thus, [Nakatsu] and the Purina Product Guide together are considered to teach a solid pet food for weight reduction that comprises Vitamin A, sorghum, and / or barely [sic, barley]. These references do not teach adding chromium and L-carnitine to the food. However, [Hastings] teaches that both of these ingredients are well known in the art for inducing weight loss. Thus, a person of ordinary skill in the art would reasonably expect that these weight loss inducing agents would be beneficial additions to the weight loss food taught by [Nakatsu] and the Purina Product Guide. Based on this reasonable expectation of beneficial results, an artisan of ordinary skill would have been motivated to combine chromium and L-carnitine with the food containing Vitamin A, sorghum, and / or barley.

Id. at 4.

Appellants argue that the combination is “a piecemeal attempt to construct Appellant’s invention,” and that “[t]he examiner has merely located a disclosure of each component recited in the present claims, but each disclosure is for a different purpose or formulation and fails to suggest any combination.” Appeal Brief, page 6. We agree.

“[T]he Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. ‘[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citation omitted). An adequate showing of motivation to combine requires “evidence that ‘a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the

claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” Ecolochem, Inc. v. Southern Calif. Edison Co., 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Thus, “the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” Ecolochem, Inc., 227 F.3d at 1371, 56 USPQ2d at 1073.

In the rejection before us, the Purina reference provides a listing of ingredients for a dry food for obese dogs, which, as acknowledged by the examiner, fails to teach using sorghum, barley, l-carnitine, or chromium in the composition.

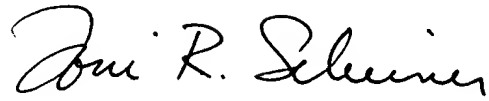
Nakatsu is drawn to an anti-obesity and fat –reducing composition, wherein the composition may be in the form of animal feed, and wherein a grain such as corn, sorghum, wheat, barley, oats and the like may be used. Although the patent teaches the use of the composition for animals generally, only cattle, sheep, poultry and swine are specifically mentioned. See Nakatsu, Col. 5, lines 19-40.

Finally, Hastings is drawn to a dietary supplement that may be used as a weight loss composition, wherein the composition is initially prepared as a dry mixture. See Hastings, Col. 1, lines 46-58. Although the patent suggests that the weight loss composition may be used for mammals generally, see paragraph bridging columns 1 and 2, it is primarily drawn to a dietary supplement for human

use, see Col. 2, lines 33-43. According to Hastings, the composition is preferably in the form of a dry mixture that may be delivered as a beverage, but may also be formulated as a lozenge, capsule, tablet, emulsion or suspension, as well as “staple foods such as cakes, cookies, weight loss candy bars, etc.” Id. at lines 58-61.

We find that even if assuming the ordinary artisan would have been motivated by the teachings of Nakatsu to substitute sorghum and/or barley for the corn in the dry dog food of Purina, one of ordinary skill would not have looked to Hastings for the addition of l-carnitine and chromium. Both Purina and Nakatsu teach animal feed compositions. Hastings, however, is drawn to a dietary supplement. Thus, one of ordinary skill in the art would not have looked to Hastings for additives to a dog food composition. Moreover, Hastings, although mentioning mammals in general, when read as a whole, is primarily drawn to human supplements and staple foods. Thus again, the ordinary artisan would not have looked to Hastings. Thus, because the rejection fails to set forth a prima facie case of obviousness, it is reversed.

REVERSED



Toni R. Scheiner
Administrative Patent Judge



Donald E. Adams
Administrative Patent Judge



Lora M. Green
Administrative Patent Judge

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